

REMARKS / DISCUSSION OF ISSUES

Claims 1, 3-10, 12 and 16-23 are pending in the application. Claim 1 is the independent claim. As no amendments to the claims are made by the present Response, a listing under Rule 121 is not required.

Rejections under 35 U.S.C. § 112

1. Claims 4, 7-10, 16, 18 and 22-23 are rejected under 35 U.S.C. § 112, ¶1 for failing to comply with the written description requirement.
2. Claim 19 is rejected under 35 U.S.C. § 112, ¶2 for indefiniteness.

With regard to the rejection under ¶1 of this section of the Code, Applicants rely on at least the following standards of law handed down by the Courts. It is well established that the written description requirement of § 112 requires the application to "convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*." *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991); *see also In re Wright*, 866 F.2d 422, 424 (Fed. Cir. 1989) ("When the scope of a claim has been changed by amendment in such a way as to justify an assertion that it is directed to a *different invention* than was the original claim, it is proper to inquire whether the newly claimed subject matter was *described* in the patent application when filed as the invention of the applicant. That is the essence of the so-called 'description requirement' of § 112, first paragraph. . . ."). The claimed subject matter need not be described "in haec verba" in the original specification in order to satisfy the written description requirement. *In re Wright*, 866 F.2d at 425. Rather, "the test . . . is whether a person of ordinary skill in the art would recognize that the applicant possessed what is claimed in the later filed application as of the filing date of the earlier filed application." *Noelle v. Lederman*, 355 F.3d 1343, 1348 (Fed. Cir. 2004).

The Office Action alleges that the inclusion in claim 4 of the transmission of user preference to the server by both the second system and another system. Moreover, the

Office Action alleges that the filed applicants does not support the reception of control data from the server by both the second system and the another system. Applicants respectfully demur.

As to the first allegation, Applicants note that the file application discloses that the first system comprises, for example, a PTV, a high end TV receiver, a projection TV, an audio jukebox, a home theater, etc. The second system comprises for example a set-top box; a PC; a digital telephone. The another system includes a remote control device. While the language may not be provided in *haec verba*, one skilled in the art would readily appreciate that remote devices and set-top boxes, for example, are configured to transmit preferences of a user to a server. Thus, there is clear support for the feature as claimed. Withdrawal of the rejection is thus respectfully requested.

As to the second allegation, the transmission of control data to a remote as well as to a set top box, for example, would be readily appreciated by one skilled in the art having had to benefit of the present disclosure; and thus, the lack of in *haec verba* description of this claimed feature does not render the feature lacking under ¶1.

As to the rejection under ¶2 of this section of the Code, Applicants respectfully submit that the language “configuring the first consumer electronics system as to functional parameters” connotes that the system is configured according to, or with, functional parameters and this would be readily appreciated, particularly in view of the specification. Withdrawal of the rejection is thus respectfully requested.

Rejections under 35 U.S.C. § 102

Claims 1, 3, 5-6, 12, 17 and 19-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Waki, et al.* Applicants respectfully submit that for at least the reasons set forth below, this rejection is improper and should be withdrawn.

At the outset Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313

(Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

Claim 1 is drawn to a method for programming a first consumer electronics system for operation **according to a user preference**, among other things. The Examiner directs Applicants to column 24, line 61 through column 25 line 3 for the alleged disclosure of programming according to a user preference. The noted portion of the reference relates to the sending by a host to a digital broadcast system key information to allow descrambling of a scrambled program. The receiving device is the recipient of the key “in accordance with a broadcast being watched by the viewer and a viewer’s operation.” The receiving device then descrambles the program with the key. Thus, the portion of the reference relied upon by the Examiner relates to descrambling of a broadcast by a receiver. There is no description of programming of a consumer electronics device. Clearly, the process of descrambling a program for user consumption as described in *Waki, et al.* and the featured programming according to a user preference are not the same. Therefore, there exists at least one difference between the subject matter of claim 1 and the disclosure of the applied art.

Because the applied art fails to disclose at least one feature of claim 1, a *prima facie* case of anticipation has not been established, rendering claim 1 patentable over *Waki, et al.* Moreover, claims 3-10, 12 and 16-23, which depend from claim 1 directly or indirectly, are patentable for at least the same reasons and in view of their additional subject matter.

Conclusion

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

s/William S. Francos/

by: William S. Francos (Reg. No. 38,456)

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